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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/694,774 | 10/29/2003 | Yuji Hirano | 244739US0 | 6704 |

22850 7590 11/30/2007

OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

| EXAMINER | |
|---|---|
| VENKAT, JYOTHSNA A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1615 | |

| NOTIFICATION DATE | DELIVERY MODE |
|---|---|
| 11/30/2007 | ELECTRONIC |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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oblonpat@oblon.com
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| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/694,774 | HIRANO, YUJI | |
| | Examiner | Art Unit | |
| | JYOTHSNA A. VENKAT Ph. D | 1615 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *07 September 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) *3,4 and 6* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-2 and 7-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

Receipt is acknowledged of election filed on 9/7/07. In response to the non-final rejection claims 3-15 were added and in view of new claims restriction is required under 35 U.S.C. 121. Claims 1-15 are pending in the application and the status of the application is as follows:

### *Election/Restrictions*

Applicant's election with traverse of group III in the reply filed on 9/7/07 is acknowledged. The traversal is on the ground(s) that all of the claims are linked with respect to utility, hair styling composition, and they all share a common nucleus, formula (1) of Claim 1 that is responsible for their activity, and as such should be examined together on the merits, especially wherein the sole disclosed utility of the product is that recited in the specification and also argue that different classification of subject matter to be divided is not conclusive proof of independent status and divisibility and it is a technical relationship that involves the same features, and it is this technical feature that defines the contribution which each of the groups taken as a whole makes over the prior art. This is not found persuasive because it is a search burden to examine all the claims drawn to different film forming polymers. Art anticipating or rendering obvious anionic polymer would not anticipate or render obvious cationic or amphoteric or nonionic polymer. The combination of diamide and each type of film former is drawn to distinct products. The instant application is filed under 35 U. S. C. 111 and not under 371 therefore examiner issued a restriction and not a lack of unity.

The requirement is still deemed proper and is therefore made FINAL.

Claims 3-4 and 6 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/7/07.

Claim 5 would be examined to the extent that it reads on the elected species, which is "vinylpyrrolidone/dimethylamino methacrylate copolymer".

Claims 1-2 and 7-15 are pending in the application and the status of the application is as follows:

The following new ground of rejection is necessitated by the amendment.

***Claim Rejections - 35 USC § 103***

Claims 1-2, 5-11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patents 6,685,953 ('953) and PGPUB 2003/0008855 A1 ('855).

The instant application is claiming hair styling composition comprising diamide and a film-forming polymer (cationic film former). Patent '953 teaches external preparations using the same claimed diamide. See the abstract, see col.s 2-6 for the diamide, see col.7, lines 41-56 and see col.8, lines 8-30, where the patent teaches using diamide in hair care art. This includes using the diamide in hair rinses, hair treatment and in hair styling. Patent does not teach film- forming polymer. However PGPUB '855 teaches styling compositions using film-former. Film-formers are used in hair styling art. See paragraphs 7-9 and paragraphs 28-29. See paragraph 34 for the cationic polymers and see the elected species under cationic polymer. PGPUB at paragraph 39 teaches that the compositions can have additives and this includes silicone derivatives (claim 15) and proteins at paragraph 45.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare hair composition of '953 and add film-forming agent of '855 and

proteins, silicone derivatives in hair styling compositions. One of ordinary skill in the art would be motivated to add film-forming agent taught by '855 into the compositions of '953 with the reasonable expectation of success that the hair can be styled and it is conventional to add film formers for styling and one of ordinary skill in the art would be motivated to add the silicones since silicones derivatives are added to condition the hair This is a prima facie case of obviousness.

Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of U.S. Patents 6,685,953 ('953) and PGPUB 2003/0008855 ('855) as applied to claims 1-2, 5, 7-11 and 15 above, and further in view of translated DE 199 02 530 ('530).

Patents '953 and 'PGPUB '855do not teach ceramides in the hair compositions. However DE document teaches ceramides. See page 2 for acylated sphigosine. See also examples. Ceramides are lipids and they exhibit conditioning property.

Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the hair composition of '953 and cationic film former, silicone derivatives, protein taught by PGPUB '855 and add ceramides taught by DE '530 in analogous hair compositions. One of ordinary skill in the art would be motivated to add the ingredients taught by '855 and DE and prepare another analogous composition with the reasonable expectation of success that new hair compositions has the advantage of providing conditioning effect and silicones are known conditioning agents and adding Ceramide also provide conditioning property. This is a prima facie case of obviousness.

***Double Patenting***

Claims 1-2 and 5 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/417,114 in view of U. S. Patent 4,834,968 ('968). Although the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are claiming compositions using the same diamide. Instant application has diamide and film forming agent, where as co-pending application is claiming dyes and oxidizing agent along with diamide and the it is obvious to add dye or oxidizing agent to the diamide since patent '968 teaches at paragraph bridging col.s 3-4 that in hair styling compositions that other ingredients like dyes and oxidizing agents can be added to hair styling compositions. This is a provisional obviousness-type double patenting rejection.

The following rejection is maintained.

Claims 1-2 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of copending Application No. 10/694,775. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the applications are claiming same diamide. It is obvious to one of ordinary skill in the art to add fatty alcohols and cationic surfactant into compostions of the instant application since these ingredients are used in the hair care art.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

***Response to Arguments***

Applicant's arguments filed 5/14/07 have been fully considered but they are not persuasive.

Applicanst argue that none of the claims of the instant application recite a higher alcohol or fatty acid or salt there of clamed in the co-pending application.

In response, the expression "comprising" in the claims is inclusive of ingredients claimed in the co-pending application.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A. VENKAT Ph. D whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Friday, 10:30-7:30:1st Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL WOODWARD can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

**/JYOTHSNA A. VENKAT/ Ph. D**
**Primary Examiner**
**Art Unit 1615**

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